## REMARKS

The Applicants have carefully considered the positions of the Examiner and respectfully requests reconsideration based upon the manifest differences between the present invention and the cited references. In the January 11, 2005 Office Action the Examiner rejected claims 48-64 under 35 U.S.C. §§ 102 and/or 103. The Applicants herein respond to those rejections and highlights the differences between the pending claims and the cited references such that it should become apparent to the Examiner that these rejections should be reconsidered and withdrawn.

Initially the Examiner objected to the amendment filed on October 21, 2004 under 35 U.S.C. § 132 arguing that it introduces new matter into the disclosure. The Applicants would like to thank the Examiner for pointing this out and have amended Claim 48 to comply with 35 U.S.C. § 132. The Applicants request that this objection be withdrawn.

Next, the Examiner rejected Claims 48 and 50 under 35 U.S.C. § 102 as being anticipated by Manian et al. U.S. Patent No. 6,130,745 ("Manian"). The Applicants respectfully submit that the Examiner's reliance on Manian is misplaced. It is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the claim or claims at issue -- Manian falls far short of this requirement.

The immediate application discloses a solid state standard constructed of glass and coated with a material that intrinsically fluoresces or absorbs at a given wavelength. In particular, the invention discloses a solid state calibration standard which is unwavering in optical density or relative fluorescence units such that reliable readings are provided over time. Manian merely teaches an optical autofocus method to locate a target layer in a microplate well, which is achieved by determining the

location of the well base surface where a maximum intensity of specular reflection is detected. Specular reflection is a result of transitions between two materials with different indices of reflection. Although Manian discloses a method for coating a surface to alter the index of reflection, he fails to teach or suggest the claimed solid state standard comprising glass coated with a material that differs in concentration from the glass linearly in a standard curve. Also, Manian fails to teach or suggest reading a concentration of a sample at standard curve points, as claimed in the present application. Accordingly, the Applicants respectfully request that the Examiner's rejection of Claims 48 and 50 under 35 U.S.C. § 102 be reconsidered and withdrawn.

Next, the Examiner rejected claims Claims 49, 51-57 and 58-64 under 35 U.S.C. § 103 as being unpatentable over Manian. Applicant respectfully submits that none of these claims are rendered obvious by Manian as suggested by the Examiner. Applicant submits that the Examiner has misconstrued the teachings of Manian, as discussed above. In particular, nowhere does Manian discuss or even suggest the claimed solid state standard comprising glass coated with a material that differs in concentration from the glass linearly in a standard curve, or reading a concentration of a sample at standard curve points. Rather, in stark contrast to the present invention, Manian merely discloses an optical autofocus method to locate a target layer in a microplate well, which is achieved by determining the location of the well base surface where a maximum intensity of specular reflection is detected, which is nothing like the solid state standard of the present invention.

Moreover, the applicant respectfully points out that, standing on its own, this reference provides no justification for the expanded teachings asserted by the Examiner.

"Obviousness cannot be established by combining the teachings of the

prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original).

The cited reference provides no such suggestion or incentive for the obviousness arguments suggested by the Examiner. The rejection could only be the result of a hindsight view with the benefit of the applicant's own teachings. However,

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." (citations omitted) *Sesonics v. Aerosonic Corp.*, 38 U.S.P.Q. 2d. 1551, 1554 (1996).

In addition, the argument advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument. The disclosure in Manian's specification and claims does not reveal any other functional or design choices that could possibly include that of the applicant's invention. Accordingly, the combinations

asserted by the Examiner would not be obvious to a person of skill in the art to arrive at the present invention. At best it might be obvious to try such a combination. Of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. §103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, it is respectfully submitted that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." Id.

Applicant submits that the only "motivation" for the Examiner's expansion or combination of the reference is provided by the teachings of applicant's own disclosure. No such motivation is provided by the reference itself.

In short, the applicant's solid state standard represents a dramatic improvement in the industry, and the cited reference neither teaches nor suggests the novel and nonobvious features of this invention. Accordingly, the Applicants request that the Examiner's rejection of Claims 49, 51-57 and 58-64 under 35 U.S.C. § 103 be reconsidered and withdrawn.

## CONCLUSION

In view of the foregoing, applicant respectfully submits that the present invention represents a patentable contribution to the art and the application is in condition for allowance. Early and favorable action is accordingly solicited.

Respectfully submitted,

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